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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10-071,469	02/08/2002	Michael David Bentley	34848/234789	1045

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,469

Applicant(s)

BENTLEY ET AL-
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Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on APR. 14, 2003
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-50 is/are pending in the application.
- Of the above claim(s) 31-50
- ☐ Claim(s) is/are withdrawn from consideration.
- ☒ Claim(s) 1-30 is/are allowed.
- ☐ Claim(s) is/are rejected.
- ☒ Claim(s) 1-50 is/are objected to.
- are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).
- *Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

1. Applicants' designation of this application as a continuation of parent case SN 09/186,759 is objected to because there was a restriction requirement in said parent case, and the claims herein correspond to one or more groups (e.g. Group II) that was/were not elected therein. Hence, this case is a division of the parent case and applicants are required to correct the first paragraph on page 1 of the specification to reflect the true relationship.

2. Applicants' election of Group I, claims 1-30 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 31-50 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 4.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 16-20 and 22 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Harris et al. 5,252,714, esp. column 5, lines 4-19, noting also column 6, line 12 as to PEG 8000.

5. Claims 1-9, 11, 14-24, 26, 29 and 30 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Phillips et al. 5,298,410, esp. Example 1-3, 6 and 7; and column 6, line 53 - column 7, line 19; or Snow et al. 5,532,154, esp. Examples 1, 3, 4, 7 and 8.

6. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-6, 8, 9, 11, 16-21, 23, 24 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,362,254. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because the stated instant claims read on, or at least overlap, the claims of the '254 patent.

8. Claims 1-8, 10-23 and 25-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,495,659. Although the conflicting claims are not identical, they are not patentably distinct from each other because the stated instant claims read on, or at least overlap, the claims of the '659 patent.

9. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 2 and 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 2 and 17 recite a Markush group which is not considered proper for the reasons that it is indefinite as to scope and incomplete as to its membership in not reciting --the group consisting of-- after "from".

11. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor

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errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

12. Applicants should insert the status of the parent case (now U.S. Patent No. 6,448,369) in the first paragraph on page 1 of the specification.

13. The remaining references listed on the attached Form PTO-1449 (two sheets) and Form PTO-892 are cumulative to the references applied herein, and/or further show the state of the art.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
June 19, 2003

Richard D. Lovering
RICHARD D. LOVERING
PATENT EXAMINER
GROUP 1700